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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/691,409   | 10/18/2000  | Jaime A Siegel       | SNY-N3422           | 3951             |
| 24337  | 7590        | 06/28/2004           | EXAMINER            |                  |
| MILLER PATENT SERVICES<br>2500 DOCKERY LANE<br>RALEIGH, NC 27606 |             |                      | KIM, AHSHIK         |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2876                |                  |

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|------------------------------|------------------------|---------------------|--|
|                              | 09/691,409             | SIEGEL, JAIME A     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Ahshik Kim             | 2876                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 4/12/04 (Amendment).

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 1-45 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 45 is/are allowed.

6)  Claim(s) 1-44 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All    b)  Some \* c)  None of:

  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### *Amendment*

1. Receipt is acknowledged of the amendment filed on April 12, 2004. In the amendment  
5 claims 3 and 36 were amended to correct typo. Currently, claims 1-45 remain for examination.

### *Claim Objections*

2. Claims 25-33 are objected to because of the following informalities: Claim 25 appears to be an apparatus claim “An electronic storage medium .....” However, claims 26-33, when  
10 referring back to claim 25 or intervening claims, they treat claim 25 and the intervening claims as a method claim. For example, claim 26 recites “The method according to claim 25 .....”  
Appropriate corrections resolving the apparent inconsistencies are required.

### *Claim Rejections - 35 USC § 103*

- 15 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
- 20 4. Claims 1-8, 10, 12-21, 23-28, 30-41, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleiman (US 5,959,945, hereinafter “Kleiman”) in view of Maes et al. (US  
25 5,264,689, hereinafter “Maes”).

Kleiman teaches a content player jukebox IT, comprising in combination: a memory which stores content, possibly a magnetic disk CM3 (see figure 1); a playback credit bank 212 stored in the player; and a method of playing the content for consumption by a user, providing the credit bank has ample playback credit, and deducting credit when content is played, evidencing that

5 there is circuitry present to perform such (see figure 7). The credit bank may be replenished by communication with smart card (col. 9, lines 3-6). The user may communicate with a service center, the center acting as a vendor, in that the smart card may be used to purchase credits via communication link, where the credits can then be transferred to the credit bank of the content player for usage (col. 14, lines 9-24). The link may be wireless or through modem (Internet) access. The credits are transferred in the form of certificates, which are decrypted before storage

10 (col. 14, lines 18-29). The service centers are stand-alone facilities, which would wholly include the realm of stand-alone transaction housings, terminals, kiosks, etc.

Kleiman fails to specifically teach or fairly suggest of charging a customer when the electronic content is repeatedly played.

15 Maes teaches a content or service dispensing system (see abstract) comprising a card further comprising credit bank (or a credit counter) (See only figure of the patent) (col. 1, lines 25+). When a product or service is purchased, the comparator compares the page counter and the credit counter to allow the purchase (col. 4, lines 39+). The credit counter can be replenished via external terminal such as credit recharging terminal.

20 In view of Maes' teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further employ well-known method of charging a customer on pay-per-play basis to the teachings of Kleiman in order to accommodate customers who may

prefer purchasing the content on one-time basis. In the media player commonly known as “jukeboxes”, receiving payment for whenever the content is played is well known and widely used payment method. Accordingly, incorporating such payment feature well known in the “jukebox” embodiment would have been obvious to one ordinary skill in the art to properly

5 collect the fee whenever the content is played.

Re claims 5-7, 20, 27, 34-41 and 43, Kleiman teaches that menus are provided on a display of content player IT, wherein what songs present in the player are shown. Being that the player is driven by credits accrued, it would have been obvious to one of ordinary skill in the art to have the available credits to be used in the player shown on such a screen, or rather the status  
10 of the credits within the player system. While it is not specifically taught, it would have been known to include such as it would obviously provide user convenience and expedience in purchasing and using credits for content playback.

Kleiman also fails to teach both the content and credits to be stored in a storage medium. It would have been obvious to one of ordinary skill in the art to provide such a combination, as it  
15 would reduce the number of storage mediums necessary to fully operate the content player. The user could conveniently perform all operational tasks using one card (purchasing of credit, accrual of content, transferal of content, etc.), adding to customer satisfaction.

5. Claims 9, 11, 22, 29, 42, and 44 are rejected under 35 U.S.C. 103(a) as being  
20 unpatentable over Kleiman as modified by Maes as applied to claim 1, 18, 25 and 34 above and further in view of Abecassis (US 6,192,340 B1, of record, hereinafter “Abecassis”). The teachings of Kleiman as modified by Kalis have been discussed above.

However, Kleiman/Kalis fail to teach the content presented on a stick memory device and the content player as being portable.

Abecassis teaches a music player 100 that contains memory for storing playback music and credits, the credits deducted when listening to the music. Figure 2 shows that the device, 5 now 200, may be portable. Column 6, lines 10+ discuss the use of different media to allow a user access to the player, those media including a cartridge, magnetic credit card, or Memory Stick.

In view of Abecassis' teaching, It would have been obvious to one of ordinary skill in the art to provide such a player as portable, as portable players, such as MP3 or CD players, are 10 notoriously well-known to allow convenience for user to carry the player anywhere he/she chooses for enjoyment, rather than just be confined to enjoy such a device in his/her home or office. Having a Memory Stick in place of a regular credit card or other storage card is a well-known, art-recognized equivalent in the industry. Stick type devices, such as Memory Sticks are known to be used in modern industry as they enable the user to carry a substantially large 15 amount of data or information. Thus, such a replacement would have been obvious to one of ordinary skill in the art to incorporate.

#### *Allowable Subject Matter*

6. Claim 45 allowed.
- 20 7. The following is a statement of reasons for the indication of allowable subject matter: the claims are directed at an apparatus and the method for playing content in repeated manner. Such content players for songs, movies or other contents are generally known in the art, and gaining a

rapid acceptance among consumers. Many prior arts have been considered. However, the cited references, taken alone or in combination, fails to teach or fairly suggest a particular method of playback of electronic media comprising the steps recited in claim 45.

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### ***Response to Remarks***

8. Applicant's remarks filed on April 12, 2004 have been carefully considered. Although a new reference is cited, it is not an indication of conceding to the points raised by the Applicant. The Kalis patent provides relevant teaching with respect to "playback credit". However, the Maes patent may be more similar to Applicant's embodiment since it uses the term "credit counter". It is the Examiner's view, however, that actual monetary value or some kind of tokens stored in a memory which allows playback or repeated downloading of the content could be interpreted as "credit bank". This Office Action is made non-final.

### ***Conclusion***

15 Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

25 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

30 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

*Ahshik Kim*

Ahshik Kim  
Patent Examiner  
Art Unit 2876  
June 23, 2004

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